

REMARKS

Claim 7 was objected to by the Examiner. The objection is traversed. As indicated in Amendment A, claim 7 was re-written in independent form. The "content provider" limitation was not part of original claim 1. There is no basis for an objection, as the claim is clearly written and no informalities are apparent. There is no "content provider" missing from the claim. The remarks in Amendment A provided a traversal of the rejection of claim 7 that was independent of the "content provider" limitation. The objection should be withdrawn.

The previous arguments are incorporated herein. To maintain the rejection of claims 1 and 14 and claims dependent therefrom, the added "content provider" limitation has been interpreted in a manner that is contrary to the present specification and ordinary meaning. It is improper to read "content provider" on claims that have been amended to indicate that the print content is from a content provider location.

The specification and ordinary meaning make clear that a content provider is not a server that stores a user's own documents, as do Eldridge's document servers. As stated in the specification, "A likely scenario involves the portable wireless device 16 accessing a content provider 18, typically a web site over the Internet. The web site might include a link to print content, such as a 'print-this' link. If selected, the print by reference target is transmitted to the portable wireless device 16, which then can commence a print by reference operation with the print device 10." P5, L8-13. Reading this, no artisan would interpret Eldridge's token-based document server that stores a user's own documents.

With regard to ordinary meaning, the specification and claimed usage is consistent with ordinary meaning, and contrary to the interpretation of Eldridge's document servers in the office action. A web search for "content provider" on Yahoo's search engine, for example, provides examples of financial content providers, stock market content providers, scholastic information content providers, etc. A search on the PTO's patent database for tti/"content provider" reveals 10 patents that

use the term "content provider" in their title and patents use content provider in a manner generally consistent with the use by applicants.

In sum, it is improper to call Eldridge's document servers that store a user's own documents "content providers". Doing so is contrary to the claims interpreted in view of the specification and ordinary meaning. Accordingly, for the reasons stated in Amendment A, the rejections of claims 1, 14 and claims depending therefrom should be withdrawn.

Regarding the rejection of claims 7 and 8, the response to the previous arguments determines that "SOAP is a lightweight protocol for exchange of information in a decentralized distributed environment". This statement is taken from the white paper on SOAP, but is irrelevant because it is the Examiner's burden in making a prima facie case to demonstrate specific motivation evidence to modify Eldridge. The fact that SOAP is a "lightweight protocol" in no way suggests its use in Eldridge, where Eldridge delivers encoded tokens over the web. Mere possibilities, e.g., that it might be possible to use SOAP in Eldridge's system, do not demonstrate that it would have been obvious to do so.

Page 15 goes on to say that "the print by reference *concept* does not require any specific protocol...and this is the reason why Eldridge does not disclosed any communication rules and regulations." (emphasis added). This statement is rank supposition. It is not clear what is meant by the "print by reference concept". Apparently, the office action takes the view that "printing by reference" as a concept has been disclosed, and this renders all manifestations, improvements, variations, etc. obvious. Such sweeping statements demonstrate the predisposition to reject the present claims, as the claims are not directed to a vague "print by reference concept" (nor is Eldridge, for that matter). Also, Eldridge does disclose communication rules and regulations. Eldridge's tokens represent a particular protocol in that the tokens must be decoded by the document server. Eldridge already has document access over the WWW, as indicated in C8, L1-10. An artisan would not be motivated to look to the three additional references for providing WWW access, therefore. Nor do any of the second, third, or fourth reference concern print by reference operations. The combination (especially when considered with the large number of other combinations

applied) indicates that the claim 7 was used as a roadmap for constructing the rejection. Yet another reason is that the token based servers used by Eldridge define an independent protocol, and it is not clear how the additional references suggest modification of a token based protocol.


It is again noted that the rejection of the claims in this case included 13 separate theories of obviousness based upon a multitude of combinations. Combined with the subsequent explanations that contradict ordinary meaning and the content of the references, indicates the use of hindsight and a predisposition to reject the claims.

The previous grounds for traversal are maintained, as is the patentability of claims not specifically addressed. For all of the above reasons, reconsideration and allowance of the application is requested. The examiner is invited to contact the undersigned attorney at the below listed number if the examiner has any questions concerning this amendment.

Respectfully submitted,

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